



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HEENAN, Sidney A., et al.

Serial No.: 09/453,327

Filed: December 2, 1999

For: RETROREFLECTIVE ARTICLES
HAVING MICROCUBES, AND TOOLS AND
METHODS FOR FORMING MICROCUBES

) Examiner: J. Phan

) Art Unit: 2872

) I hereby certify that this correspond-
) ence is being deposited with the U. S.
) Postal Service as first class mail in an
) envelope addressed to: Commissioner of
) Patents and Trademarks, Washington,
) D.C. 20231, on 1/11/02

) Janette Haseltine
) JANETTE HASLTINE

RESPONSE

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is in response to the Office Action mailed October 11, 2001.

With regard to paragraphs 1 and 2 of the Office Action, applicants note with appreciation that previously withdrawn claims 18 and 91-93 have been rejoined with the elected invention. Applicants acknowledge that claims 14-17, 19-25, 27-28, and 31-90 are withdrawn from further consideration as being drawn to a non-elected invention.

In regard to paragraph 3 of the Office Action, applicants submit herewith a new Terminal Disclaimer in compliance with MPEP § 1490. It is believed that this Terminal Disclaimer overcomes the double patenting rejection of paragraph 4.

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In regard to paragraph 5 of the Office Action, the rejection of claims 1-11, 18 and 29-30 as being anticipated by Jungersen is respectfully traversed. Independent claim 1 reads as follows:

An article comprising an array of microcubes, at least one of said microcubes being non-hexagonal, such that for every plane in space there are two adjacent microcubes for which at the place of the adjacency none of the face edges is parallel to that plane.

As the Examiner correctly states, Jungersen discloses a retroreflective sheeting comprising triangular microcubes which are not hexagonal. The triangular microcubes of Jungersen are made by ruling grooves in a planar substrate. Thus, the plane of the substrate surface is parallel to each of the face edges of the cubes where the cubes are adjacent to one another. Therefore, the illustrated cube arrays of Jungersen do not meet the limitation of the second clause of claim 1, namely, that for *every* plane in space there are two adjacent microcubes for which at the place of the adjacency *none* of the face edges is parallel to that plane. Since the Jungersen arrays do not meet this limitation, claim 1 is not anticipated by Jungersen. Claims 2-11, 18 and 29-30, all of which depend from claim 1, either directly or indirectly, also are therefore not anticipated by Jungersen.

In regard to paragraph 6 of the Office Action, the rejection of claims 1-11, 18, 26, 29-30, and 91-94 as anticipated by Heenan '090 is respectfully traversed. Applicants refer to the Remarks and declaration evidence submitted in their prior response in this case filed on April 5, 2001 and incorporate the same herein by reference. The Examiner has stated that the declarations are not given much weight because all patents are presumed to be valid. Applicants respectfully point out that the '090 patent discloses many different embodiments. These different embodiments recite many different dimensions such as, for example, in the paragraph spanning

columns 5 and 6; in column 7, lines 12-27; and in column 9, lines 17-36. Each of these embodiments is fully enabled by the specification of the '090 patent and these embodiments are covered by the claims. The only claim that recites specific dimensions is claim 5, which states that the major dimension of each of the cells can be no greater than about 0.35 inch. This claim is fully enabled and is supported at column 5, line 64 - column 6, line 1 and at column 9, lines 25-29. Similarly, the other claims of the '090 patent are not invalid, because they each cover other embodiments that are fully enabled by the '090 disclosure. Applicants herein are stating only that the single embodiment described at column 10, lines 5-22 of the '090 patent is not enabled, as demonstrated by the declarations under 37 CFR § 132 previously submitted. This is the embodiment in which the length of the side of each of the cells 410 is 0.04 inch. This particular embodiment of the '090 patent is not specifically recited in any of the claims of the '090 patent. Since that one embodiment of the '090 disclosure is not enabled, it cannot serve as a basis for anticipation of claim 1 of the instant application. Since claim 1 is not anticipated, claims 2-11, 18, 26, 29-30, and 91-94 also are not anticipated.

Applicants note with appreciation the allowance of claim 12.

As it is believed that all bases for rejecting the pending claims have been overcome, a Notice of Allowance is respectfully requested. A fee for the Terminal Disclaimer is submitted herewith. A fee for the Terminal Disclaimer was also submitted with the response filed April 5, 2001. To the extent the fee submitted herewith is deemed unnecessary in view of the payment of

the earlier fee, it is respectfully requested that the amount be credited to Deposit Account

No. 10-1202.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Sandra B. Weiss", is written over a horizontal line.

Sandra B. Weiss

Reg. No. 30,814

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